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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,956	12/17/2001	Stephen Philip Jackson	MEWE 014	2902

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EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,956

Applicant(s)

JACKSON ET AL.

Examiner

Terry A. McKelvey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-58 is/are pending in the application.
- 4a) Of the above claim(s) 41, 43-48 and 54-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38, 40, 42 and 49-53 is/are rejected.
- 7) ☒ Claim(s) 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/17/01</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I, Rad53 FHA1 domain of SEQ ID NO:9, claims 38-40, 42, and 49-53 in the reply filed on 8/27/04 is acknowledged. The traversal is on the ground(s) that all of the claims fall within a single inventive concept, phospho-dependent binding of FHA domains to phosphopeptides, the product and method inventions are so linked that a search relevant to the product claims must embrace both product and method art, thus there is no serious burden. This is not found persuasive because phospho-dependent binding of FHA domains to phosphopeptides is a natural feature of the domains and thus cannot be a special technical feature because a natural feature is not a contribution over the art. Also, as shown by the rejections below, the elected invention is rejected over prior art and thus there is no special technical feature in common between the groups. Finally, most of the groups do not feature a limitation to phospho-dependent binding of FHA domains to phosphopeptides and thus the alleged special technical feature is not present. Regarding the search for the methods and products being linked, this argument is not persuasive because as shown by the cited art used in the rejections, at

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least some of the methods and products are not rejectable. Therefore, additional searches drawn to the specific differences between the products and methods would have to be performed for each group because they are drawn to different potential special technical features. This is a serious burden because even though some art can be potentially identified in one search that applies to one or more of the other groups, it does not mean that a thorough search of one group results in a thorough search of all of the other groups, and in fact in the instant case it does not occur because the different groups have different limitations that must be searched for separately. Performing more than one of these types of searches (i.e., for more than one potential special feature) would be a serious burden.

The requirement is still deemed proper and is therefore made FINAL.

Claims 41, 43-48, and 54-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/27/04.

Specification

The substitute specification filed 12/17/04 has been entered.

Claim Objections

Claims 38-40, 42, and 49-53 are objected to because of the following informalities:

1. At the end of method step (b) of claims 38, 40, etc, the semi-colon is more properly a comma because the following wherein clause modifies the previous part of the claims.

2. Steps (a) and (b) of claims 38, 40, etc should be separated by "and".

3. Claims 40, etc, uses a semi-colon at the end of the preamble instead of the more proper colon or even no punctuation.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 49-53, the use of "A method according to ... claim 41" renders the claims vague and indefinite because claim 41 is not a method claim. It appears that claim 42 was intended.

Regarding claim 51, the use of "further comprising purifying and/or isolating a test substance and/or substance of interest from a mixture or extract" renders the claims vague and indefinite because it is unclear whether "substance" used in the instant context is the same as recited in claim 38, or whether it is a different substance. Also, because claim 40 does not recite a substance of any kind, it is unclear what relation the limitations of claim 51 has to claim 40. In other words, how does the additional method step integrate into claim 40?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38, 40, 42, and 49-52 are rejected under 35

U.S.C. 102(a) as being anticipated by Sun et al (Applicant reference AI).

Sun et al teach an assay in which GST-Rad53 (which is a fusion protein which comprises an FHA domain which is not Rad53p) is brought into contact with Rad9 or Rad9 fusion protein (which is a phosphopeptide which is not Rad9p) in the presence of a test substance (CIP, MMS, or HU), and the phospho-dependent binding of the FHA domain to Rad9 was determined (Figures 1-3). The FHA domain in GST-Rad53 reads on a test FHA and the Rad9 fusion protein reads on a test phosphopeptide. The in vitro assays read on test sample containing the phosphopeptide and other assay components. The amount of test substance added to the assay is known and thus is quantified. The test substance was supplied in a purified form and thus reads on the method step of purifying and/or isolating the test substance (when it was manufactured). The phosphoprotein and the FHA containing protein was labeled with a detectable label in the immunoblot, for example (Figures 1-3).

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Claims 42 and 52-53 are rejected under 35 U.S.C. 102(a) as being anticipated by Vialard et al (Applicant reference AJ).

Vialard et al teach an assay comprising bringing a test phosphopeptide 10HisRad9 which is phosphorylated from UV treatment into contact with Rad53, and co-fractionation was determined between the two proteins only when the proteins were both phosphorylated (and thus the end-point of the assay is phosphorylation of Rad53p) (page 5684, column 1). This reads on the claimed assay method for identifying a phosphopeptide which has phospho-dependent binding for an FHA domain.

Conclusion

No claims are allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is 571-273-8300. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

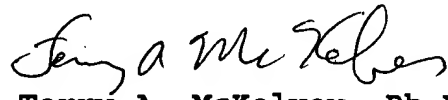
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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (571) 272-0775. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached at (571) 272-0781.


Terry A. McKelvey, Ph.D.
Primary Examiner
Art Unit 1636

June 26, 2005